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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/658,245	09/08/2000	Lester D. Nelson	EXPL-01028US0 MCF/KJD	3031
23910	7590	03/21/2006	EXAMINER	
FLIESLER MEYER, LLP FOUR EMBARCADERO CENTER SUITE 400 SAN FRANCISCO, CA 94111			PATEL, HEMANT SHANTILAL	
			ART UNIT	PAPER NUMBER
			2614	

DATE MAILED: 03/21/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/658,245	NELSON ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Hemant Patel	2645	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 06 February 2006.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-4 and 10-15 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4 and 10-15 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)             | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

**DETAILED ACTION**

***Response to Amendment***

1. Applicant's arguments with respect to claims 1-4 and 10-15 have been considered but are moot in view of the new ground(s) of rejection.

***Claim Rejections - 35 USC § 112***

1. Claims 1-4, 10-15 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The independent claims 1 and 15 recite "invoked by a user for dynamic interactive use with a second user of the stored conversation elements" (claim 1, ll. 9-10, claim 15, ll. 7-8). It is not clear if it means "invoked by a user of the stored conversation elements for dynamic interactive use with a second user" or it means "invoked by a user for dynamic interactive use with, a second user of the stored conversation elements". The Office interprets it to be "invoked by a user of the stored conversation elements for dynamic interactive use with a second user".

2. Independent Claim 15 recites the limitation "the processing device" in line 7. There is insufficient antecedent basis for this limitation in the claim.

***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1, 3, 12, 14 are rejected under 35 U.S.C. 102(b) as being anticipated by Wolff (US Patent No. 5,327,486).

***Regarding claim 1***, Wolff teaches of a telecommunications infrastructure, comprising:

(a) a first electronic device (Fig. 1, item 22, calling telephone), coupled to the telecommunications infrastructure;

(b) a second electronic device (Fig. 1, item 18, used by called wireless party) coupled to the infrastructure, for providing conversation representation (Fig. 8);

(c) a processing device (Fig. 1, item 16, radio network), coupled to the telecommunication infrastructure and remote to the first device for storing 1) a conversation element (Fig. 8, 9; col. 6, ll. 38-39, predefined messages stored by PTM) associated with the conversation representation (Fig. 8) and 2) a software program for providing an audible utterance to the first electronic device in response to a selected conversation representation (col. 2, ll. 51-53), wherein the processing device can be invoked by a user of the stored conversation elements (Fig. 1, item 18) for dynamic

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interactive use with a second user (Fig. 1, item 22), and for text-to-speech conversion for real-time dynamic input with the second user (Fig. 9; col. 6, ll. 40; col. 5, ll. 1-6); and

(d) a recording device coupled to the second electronic device for audio recording into an utterance data store (col. 6, ll. 41-45); and

(e) a switchable audio input adapted to allow a user to voice directly into the second electronic device when appropriate (Fig. 4, route call to me; col. 5, ll. 29-37).

**Regarding claim 3**, Wolff further teaches of the second electronic device generates an out-of-band signal in response to a conversation representation selection (Abstract, ll. 7-12).

**Regarding claim 12**, Wolff further teaches the radio network (processing device) acts as a relay between the calling wireless terminal and the called wireless terminal (see the claim 1 rejection for further details).

**Regarding claims 14**, Wolff further teaches of telecommunication infrastructure including wireless telephony application (Fig. 1, item 16)

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1, 15 are rejected under 35 U.S.C. 102(b) as being anticipated by Montgomery (UK Patent Application GB 2 183 880 A).

**Regarding claim 15**, Montgomery teaches of a telecommunications infrastructure, comprising:

(a) a first electronic device (Fig. 2, human user using telephone), coupled to the telecommunications infrastructure;

a second electronic device (Fig. 2, TDD device used by deaf person) coupled to the infrastructure, and remote to the first device for providing conversation representation (Fig. 3, item 11), and for storing 1) a conversation element (Fig. 3, item 11; pg. 2, ll. 93-98, 115-116) associated with the conversation representation and 2) a software program for providing an audible utterance to the first electronic device in response to a selected conversation representation (Fig. 3, item 12, text-to-speech conversion and transmission to first device); wherein the processing device can be invoked by a user of the stored conversation elements (Fig. 3, items 10, 11, 12) for dynamic interactive use with a second user (pg. 2, ll. 26-29), and for text-to-speech conversion for real-time dynamic input with the second user (pg. 2, ll. 120-121); and

(d) a recording device coupled to the second electronic device for audio recording into an utterance data store (Fig. 3, item 11, prerecorded announcements inherently suggests recording messages); and

(e) a switchable audio input adapted to allow a user to voice directly into the second electronic device when appropriate (pg. 2, ll. 47-52, switch relay to allow user to speak directly into the telephone line).

**Regarding claim 1**, recites processing device containing stored elements for conversation representation but does not specify where the processing device is

located. Claim 15 specifically recites conversation elements in second user device.

Thus claim 1 is broader than claim 15 and refer to claim 15 rejections for claim 1 rejection.

***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 2, 4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wolff as applied to claim 1 above, and further in view of Swistock (US Patent No. 6,389,115 B1).

***Regarding claims 2, 4,*** Wolff does not teach of in-band and DTMF signaling.

However, in the same field of communication, Swistock teaches of using in-band signaling with DTMF (col. 1, ll. 37-38, playing DTMF signal).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify Wolff to include the use of in-band signaling including DTMF as taught by Swistock in order to provide "an indication of a new message and the number of messages previously recorded in the system" (col. 1, ll. 38-40).

9. Claims 10, 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wolff as applied to claim 1 above, and further in view of Parikh (US patent No. 6,408,177 B1).

**Regarding claim 10**, Wolff teaches of second device being mobile terminal.

Wolff does not teach of first and second device being mobile telephones.

However, in the same field of communication, Parikh teaches of using mobile telephones for first and second electronic devices (Fig. 2, item 101, 106).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify Wolff to include mobile telephones as first and second electronic device as taught by Parikh in order to avoid "subscriber confusion and inability to hear selections in a noisy environment by presenting the menu options in a text format" (col. 2, ll. 57-60) that "can be displayed on the display screen in the subscriber's mobile handset" (col. 2, ll. 60-61) and also avoid "the problem of requiring the user to speak into the handset in an environment where the subscriber prefers not to speak" (col. 2, ll. 65-67).

**Regarding claim 11**, Wolff does not teach of Internet.

However, Parikh teaches of a wireless, incoming call management. Further, Parikh teaches that the user replies to the incoming call by sending SMS data messages to the call management center via a data channel routed through the Internet (col. 5, lines 40-50).



Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify Wolff to couple the radio network to a call management system via the Internet as taught by Parikh.

The suggestion/motivation for doing so would have been that using a data network (such as the Internet) to respond to incoming calls would have increased efficiency and reduced cost by conserving air time and network resources (Parikh, abstract).

10. Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Wolff as applied to claim 1 above, and further in view of Dowens (U.S. Patent No. 6,389,114 B1).

***Regarding claim 13,*** Wolff does not teach that the device provides utterances during a conference call.

However, Dowens teaches of a relay device, where the relay of Dowens also relays the messages during a conference (abstract).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify Wolff to add conferencing capability as taught by the relay device of Dowens.

The suggestion/motivation for doing so would have been to increase the flexibility and efficiency of the telephone communications system by allowing multiple participants to conference together during a single call instead of requiring each party to establish point to point calls when information is exchanged. In addition, such a modification

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would have conformed to telephone industry standard support for conferencing capability especially in a business environment.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hemant Patel whose telephone number is 571-272-8620. The examiner can normally be reached on 8:00 AM - 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Fan Tsang can be reached on 571-272-7547. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

HSP



Hemant Patel  
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Art Unit 2645



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